



#21 Supplemental
Reply
Appeal Brief
Louman

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7/7/03

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: 09/444,660, "Dietary supplement selector and method"

Dear Sir:

Enclosed are the following items:

Reply Brief on Appeal (3)

Postcard to be file stamped and returned.

Sincerely,

E. Petrus
Edward J. Petrus, M.D.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Edward J. Petrus

Serial No. 09/444,660

Filed: November 22, 1999

For: Dietary Supplement Selector and Method



Examiner: Rachel L. Porter

Group Art Unit: 2166

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

REPLY BRIEF ON APPEAL

Applicant/Appellant, Edward J. Petrus, presents this Reply Brief, to deal with the basic errors contained in the Examiner's Brief and thereafter with the specific matters which seem in most urgent need of correction. It is of interest to note that neither, Examiner, Rachel L. Porter or Conferee, Alexander Kalinowski, have been listed as an examiner on any issued patents.

The question before the Appeals Board is whether it would have been obvious to one of ordinary skill in the art, working with Summerell (USPN 5,937,387) in view of Riley (USPN 5,976,568) before him, could invent a method/process of creating a dietary supplement profile for an individual, after completing a health questionnaire (1*) and comparing the questionnaire information to an optimal health profile in a computer data base (2*), adjusting for differences in the individual's health information and generating a computer-implemented dietary supplement profile (3*) listing the vitamins, minerals, amino acids, enzymes and herbs suggested for optimal health.(Claim 1) The invention further comprises incorporating the information provided by a physical examination (5*) and laboratory studies (6*) to refine the health profile.(Claim 2 & 3) The invention also provides a list of commercial products (4*) that provide the dietary supplements suggested in the optimal health profile.(Claim 4) And finally by adding a plan for weight management. (Claim 5). *refer to Figure 1 of the patent application.

The Examiner would have us believe that a person of ordinary skill in the art would be motivated to combine a system that calculates survival rate by determining the users "physiological age" and providing a wellness plan based on risk factors with seven different multivitamin

formulations to achieve the applicant's invention.

Claim Rejections - 35 USC § 103

1. Modification of Summerell

The Examiner erred when claiming that "Summerell et al teach a method for creating a dietary supplement profile for an individual..." (Exam. Ans. Pg. 4, lines 5-6). The Examiner, in the First Office Action (Pg. 10, lines 6-7) stated that "Summerell et al teach a method for customizing a personal wellness plan for an individual..." In his abstract, Summerell's patent was claimed to be "[a] System and Method for Developing a Customized Wellness plan for measuring a user's wellness by determining a user's physiological age." Summerell does not use the phrase "dietary supplement profile" in any of the claims, abstract, 30 figures or specifications. The CCPA and the Federal Circuit has consistently held that when a § 103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the prima facie case of obviousness can not be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

2. Claim 1 is distinguished from Summerell and Riley

The Examiner erred when alleging Summerell as "generating a computer-implemented dietary supplement profile..." (Pg. 4, lines 11-12). Summerell states that "An object of the present invention [is] to provide a system that counsels individuals in a meaningful way to adopt and maintain healthy behaviors"(Col. 2, Lines 57-59) considering such issues as: driving while intoxicated, eating between meals, education level of spouse, firearms, helmet use, parent's divorce, safety belt use, social contacts, suicide attempt, traffic tickets..." "among others in the calculation of physiological age." (Col 3, lines 18-41).

None of the 38 claims of Summerell teach or suggest the generation of a computer-implemented dietary supplement profile. Summerell offers no computer-controlled feedback loop by which the consequences of an event send back data that in turn modify that event in the future.

The Examiner admits that "it is unclear if the system/method of Summerell adjusts for differences between the individual's health information when compared to an optimal health profile then generates a dietary supplement profile suggested for an optimal health profile." (Pg. 5, Lines 12-15). This admission by the examiner nullifies any rejection for obviousness under § 103. The

Court in *Jones v. Hardy*, 727 F.2d 1524, 1529 (Fed. Cir. 1984) held that in determining obviousness, one must consider the invention as a whole; small differences between the claims and the prior art can therefore give rise to patentability.

After citing *Graham v. John Deere Co.* 383 U.S. 1, 148 USPQ 459 (1966) the Examiner again admits that “[t]he primary reference, Summerell et al, does not specifically disclose adjusting for differences between the individual’s health information when compared to an optimal health profile, as claimed by the Appellant.” (Pg. 11, lines 17-19). In fact, no generation of a dietary supplement profile is taught or suggested by Summerell.

The Examiner erred with the statement that “Riley teaches a method that adjusts for differences in the individual’s health profile compared to an optimal health profile and generates a dietary supplement profile based on the individual’s health information.” (Pg. 5, lines 16-18). In fact, Riley teaches a method of providing seven (7) different multi-vitamin and mineral coated tablets. (Col. 4, lines 44-67; Col. 5, lines 1-21). In Riley, there is no mechanism for determining what vitamin or mineral deficiencies exist, nor is there any system/method of determining which of the seven multi-vitamins to take. Riley does not use any health questionnaire, nor does it generate any health profile. Riley has five (5) claims that outline the multi-vitamin compositions.

The Examiner erred when commenting that the “Background” information was “provided to identify problems that existed regarding nutritional supplementation at the time of the Riley invention.” (Pg. 15, lines 7-12). In fact, Riley admitted that “the most reliable method of assessing nutritional status” was by “the use of laboratory methods” for “blood and tissue levels of vitamins” and “history taking, physical examination and appropriate laboratory testing.” (Col 2, lines 42-49; 62-66). Riley’s goal was to avoid the more accurate and expensive means of improving public health by selecting seven (7) different multivitamin and mineral supplement tablets which are “directed to specific target populations.” (Col. 1, lines 21-30). The health questionnaire, lab studies and physical exam used in the applicant’s invention are taught away by Riley, and this nonobviousness of the prior art’s teaching away was held to prevent a purported § 103 rejection. *United States v. Adams*, 383 U.S. 39, 148 USPQ 497 (1966).

The Examiner erred when it was stated that “the decisions in *United States v. Adams* and *In re Fine* are moot.” (Pg. 16, lines 1-2). Black’s Law Dictionary, 5th ed. defines a case as “moot”

“when a determination is sought on a matter, which, when rendered, cannot have any practical effect on the existing controversy. *Leonhart v. McCormick*, D.C.Pa, 395 F.Supp. 1073, 1076.” *United States v. Adams* is not moot, since it renders a § 103 rejection for obviousness invalid. *In re Fine*, 837 F.2d 1071 (Fed Cir 1988) is not moot. In *Fine* the Court held that the PTO had not established a prima facie case of obviousness. “The references applied by the Board and Examiner were improperly combined, using hindsight reconstruction, without evidence to support the combination and in the face of contrary teachings in the prior art.” One of the references (Eads) “diverge from and teach away from the invention at hand” as does the Riley reference in the instant application. The Court held that neither reference alone or in combination, suggested the claimed invention.

How does Summerell teach or suggest someone to select one of Riley’s multivitamin tablets? It doesn’t. Contrary to the Examiner’s claim, combining Summerell and Riley don’t teach or suggest the Applicant’s invention.

3. Claim 2 is distinguished from Summerell and Riley

The Examiner erred alleging that information from a physical exam can be compared to health profile data and make a dietary supplement profile. (Pg. 6, line 22; Pg. 7, lines 1-3).

As the invention is defined by the language in the claims, a review of the 38 claims of Summerell and the 5 claims of Riley, no reference is made to using data from a physical exam to achieve a dietary supplement. Applicant’s invention “can be further individualized by supplementing information provided by a physical exam which allows the practitioner to input data such as blood pressure, pertinent physical and emotional findings, current medications, body fat analysis, and any contraindications to dietary supplements.” (Application Pg 3, lines 13-15).

4. Claim 3 is distinguished from Summerell and Riley

The Examiner erred when stating that “laboratory information are compared to health profile data in making a dietary supplement profile.” (Pg. 7, lines 5-17). No such dietary supplement profile is claimed by Summerell or Riley. Applicant’s invention incorporates laboratory studies to provide additional insight into the consumer’s health status. “Laboratory studies that could be input into the database by example comprise: complete blood count and urinalysis, automated blood analyses, serum vitamin levels, hair analyses or essential metabolic analysis for nutritional assessment testing.” (Application Pg 3, lines 15-19).

5. Claim 4 is distinguished from Summerell and Riley

The Examiner erred in stating that Summerell teaches a method that also includes adding a list of commercially available products that provide the dietary supplements listed in an optimal health profile. (Pg. 7, lines 20-22). The application clearly distinguishes over the reference to Summerell, which recommends the same amount of vitamin C, vitamin E and folate as in a one-size fits all vitamin tablet, provides no feedback to modify the amount of vitamins, and makes no reference to other vitamins, minerals, amino acids, enzymes or herbs. Summerell offers no computer-controlled feedback loop by which the consequences of an event send back data that in turn modify that event in the future. Riley teaches a method of providing seven (7) different multi-vitamin and mineral coated tablets. (Col. 4, lines 44-67; Col. 5, lines 1-21). In Riley, there is no mechanism for determining what vitamin or mineral deficiencies exist, nor is there any system/method of determining which of the seven multi-vitamins to take. Riley does not use any health questionnaire, nor does it generate any health profile. Riley has five (5) claims that outline the multi-vitamin compositions. Applicant's invention "can be further defined into commercially available products, for both the convenience of the consumer or for the benefit of the commercial provider." (Application Pg. 2, lines 20-22).

6. It was not obvious to the Examiner to combine Summerell and Riley

The Examiner stated that "[a]t the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Summerell with the teachings of Riley." (Pg. 12, lines 5-7).

It wasn't obvious to the Examiner. Riley was not cited in the First Office Action, but in the Final Office Action. After it became obvious that Summerell could not sustain a § 102 rejection for anticipation, the § 102 rejection was withdrawn (Pg. 18, line 3) and Riley was inserted to claim a § 103 rejection for obviousness when combined with Summerell. Such action by the Examiner violates MPEP § 706.07 which states that going "from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection."

It wasn't obvious to the inventor/pro se-appellant who has standing as one of ordinary skill

in the art.

The Court, *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987) held that the PTO “failed to establish a prima facie case of obviousness” and stated:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir 1984).

Accordingly, even if all elements of a claim are disclosed in various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention. See *In re Regal* 188 USPQ 132 (CCPA 1975). Neither Summerell or Riley teach or suggest such a combination to arrive at the applicant’s invention.

7. No clear issue was developed between the Examiner and applicant

The Examiner erred when stating that the Appellant never indicated that there was any vagueness or lack of clear issues regarding the telephone interview on June 10, 2002. (Pg. 18, lines 19-20). In fact, during the telephone interview, applicant made claim amendments that were approved as acceptable by the examiner and Supervisory Patent Examiner Joseph Thomas. The amended response was sent on June 11, 2002, with the understanding that any objections were resolved by amendments to the claims, and were acceptable for allowance. Applicant was surprised when a final office action and rejection of all claims was sent on September 11, 2002.

The Examiner erred when stating that Applicant’s after final response, received 10/22/02, “does not indicate a lack of clarity in the Examiner’s objections.” (Pg 18, lines 21-22). Applicant protested the Examiner’s responses as “void for vagueness” and clearly stated:

MPEP § 706.07 states that “[b]efore final rejection is in order a clear issue should be developed between the examiner and applicant.” That has not happened in this case. No clear issue has been communicated to the applicant from the examiner. This case was filed 11/22/99 and the first office action was 3/22/02, twenty-eight (28) months later. Why the rush to close the case? (After final response Pg.2, lines 8-11).

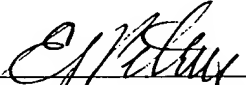
This issue is part of the reason that prompted the appeal, claiming that the office action was not final. The lack of clarity by the Examiner and failure to articulate clear issues for the applicant have led to this appeal.

Conclusion

In view of the foregoing, it is clear that Summerell and Riley, taken alone or in combination, do not express, imply or suggest the invention of claim 1. It is also clear that the examiner has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to be obvious in light of the teachings of the references. Thus, the examiner has fallen victim to the insidious effect of the hindsight syndrome.

It thus follows that a *prima facie* case of obviousness in the present case has clearly not been established, and that independent claim 1 is therefore clearly patentable. Dependent claims 2-5 are directed to even more details of the specific invention and thus further limit claim 1 in a patentable sense. Therefore, these claims are also in condition for allowance for the reasons indicated above. It is therefore requested that the above rejections be overturned and that claims 1-5 be passed to issue.

Respectfully submitted, :


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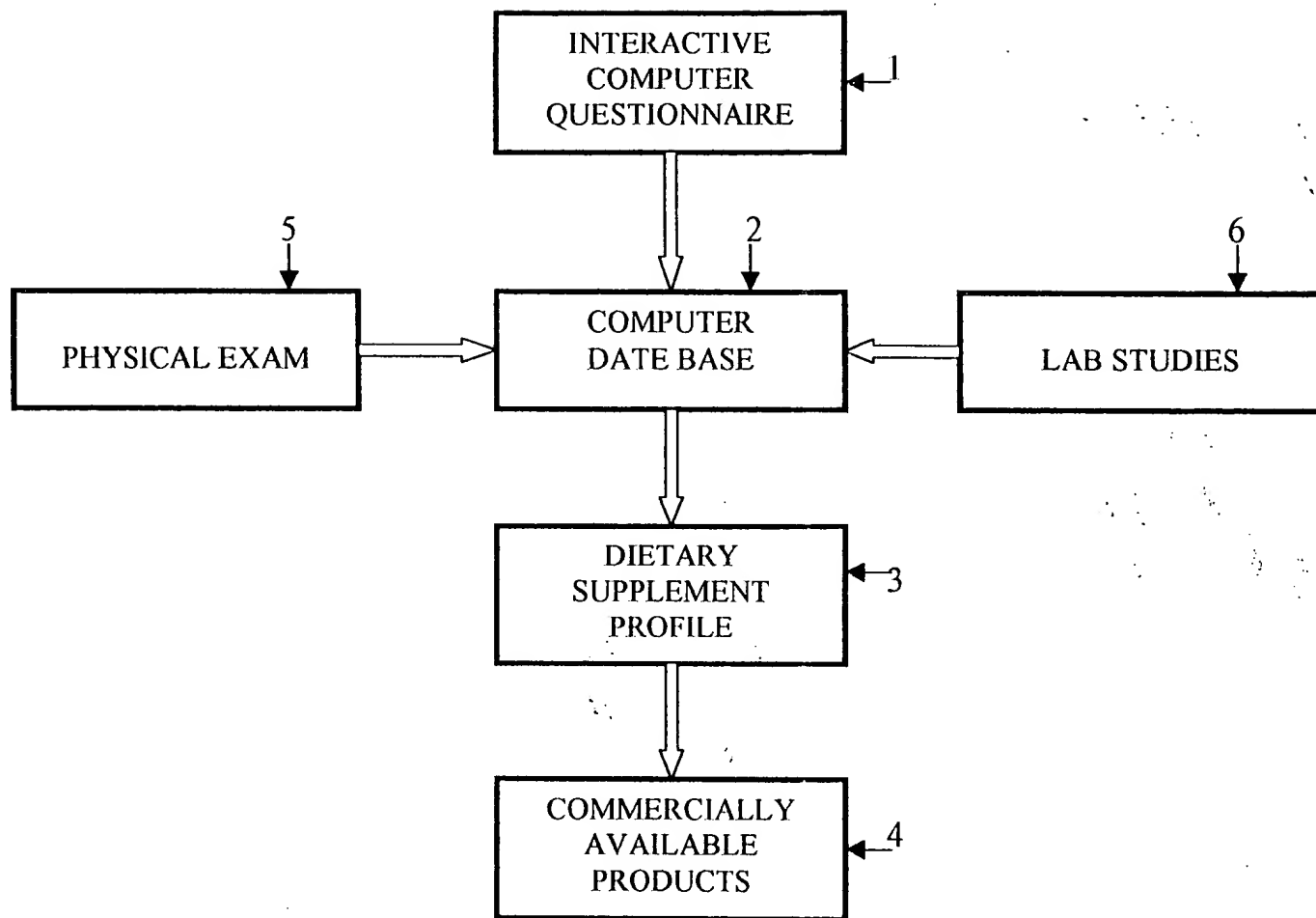


FIG. 1